

where

$R^{11}$  and  $R^{12}$  are different and are a hydrogen atom, a halogen atom, a  $C_1$ - $C_{10}$ -alkyl group, a  $C_1$ - $C_{10}$ -fluoroalkyl group, a  $C_6$ - $C_{10}$ -aryl group, a  $C_6$ - $C_{10}$ -fluoroaryl group, a  $C_1$ - $C_{10}$ -alkoxy group, a  $C_2$ - $C_{10}$ -alkenyl group, a  $C_7$ - $C_{40}$ -arylalkyl group, a  $C_8$ - $C_{40}$ -arylalkenyl group or a  $C_7$ - $C_{40}$ -alkylaryl group,

$R^{13}$  is a hydrogen atom, a halogen atom, a  $C_1$ - $C_{10}$ -alkyl group, a  $C_1$ - $C_{10}$ -fluoroalkyl group, a  $C_6$ - $C_{10}$ -aryl group, a  $C_6$ - $C_{10}$ -fluoroaryl group, a  $C_1$ - $C_{10}$ -alkoxy group, a  $C_2$ - $C_{10}$ -alkenyl group, a  $C_7$ - $C_{40}$ -arylalkyl group, a  $C_8$ - $C_{40}$ -arylalkenyl group or a  $C_7$ - $C_{40}$ -alkylaryl group,

or  $R^{11}$  and  $R^{12}$ , or  $R^{11}$  and  $R^{13}$ , in each case together with the atoms connecting them, form a ring,

$M^2$  is silicon, germanium or tin,

$R^8$  and  $R^9$  are identical or different and are as defined for  $R^{11}$ , and

$m$  and  $n$  are identical or different and are zero, 1 or 2, where  $m$  plus  $n$  is zero, 1 or 2.

#### REMARKS

The applicants respectfully request reconsideration in view of the amendment and following remarks. Support for amended claim 1 can be found in the original claim 1. The applicants deleted the bridging members that do not contain  $R^{12}$  and  $R^{13}$ .

Claims 1-3 were rejected on the basis of interference estoppel. The applicants respectfully traverse this rejection.

### INTERFERENCE ESTOPPEL

Claims 1-3 rejected on the basis of interference estoppel under 37 CFR §1.658(c). The applicants believe that the claimed subject matter is patentably distinct over the count. As the Examiner correctly stated, the count was very broad and included the possibility that the bridging groups can be the same or different.

During the interview conducted July 7, 2000, the Examiner stated that interference estoppel would apply and referred to *Ex parte Tytgat*, 225 U.S.P.Q. 907 (Bd. App. 1985). In this case, the Board did not believe that the difference (in the claimed invention) renders the subject matter on appeal patentably distinct from the subject matter of the "lost" counts. *Ex parte Tytgat, supra* at page 910.

Furthermore, the Board stated,

"Thus, it is our view that if a patent is issued to Tytgat containing the claims on appeal, **two patents claiming patentably indistinct inventions will have been issued.**" *Tytgat, supra* at page 910. (Emphasis added)

There is clearly not the applicants' situation since there is no overlap between the applicants' claimed invention and Karl's claimed application (the application involved in the interference). The two patents are not claiming the same invention. Karl's application does not disclose nor claim that the substituents in the bridges are different. The applicants' claimed invention requires that the substituents are different.

The Board further emphasized at page 911,

**"We think it most unlikely that Congress could have intended for two patents to be issued to different parties for a single inventive concept."**

Emphasis added

Again, as stated above, the applicants believe that the Declaration from Dr. Winter establishes that the applicants' claimed invention is patentably distinct from the Count of the interference.

The applicants believe that a more recent decision *Ex parte Deckler* 21 U.S.P.Q.2d 1872 (Bd. App. 1991) is also applicable. In this case, the Board of Appeals stated that interference estoppel is proper with respect to claims that contain subject matter identical to both applications and relied upon *Ex parte Tytgat, supra*. However, the Board in this case reversed the rejections of interference estoppel inasmuch as the claims do not read directly on common disclosure of the losing and winning parties and cited *In re Risse*, 378 F.2d 948, 154 U.S.P.Q. 1 (C.C.P.A. 1967) and *In re Wilding*, 535 F.2d 631, 190 U.S.P.Q. 59 (C.C.P.A. 1976). (See *Ex parte Deckler, supra* at page 1874). As stated above, Karl does not have any disclosure that states that the substituents on the bridge can be different. For the above reasons the applicants respectfully request that this rejection be withdrawn.

A one month extension fee has been paid. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the

Commissioner is authorized to charge any debit or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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